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PTO SB.21 (08-00)

Approved for use through 10/31/2002 OMB 0651-0031

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|--|--|-------------------------------|-------------------|
| TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i> | | Application Number | 08 926,592 |
| | | Filing Date | September 9, 1997 |
| | | First Named Inventor | Shunpei YAMAZAKI |
| | | Group Art Unit | 2813 |
| | | Examiner Name | M. Whipple |
| Total Number of Pages in This Submission | | Attorney Docket Number | 740756-001717 |

| ENCLOSURES (check all that apply) | | |
|---|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Assignment Papers <i>(for an Application)</i> | <input type="checkbox"/> After Allowance Communication to Group |
| <input checked="" type="checkbox"/> Fee Attached | <input type="checkbox"/> Drawing(s) | |
| <input checked="" type="checkbox"/> Response to Election of Species | <input type="checkbox"/> Licensing-related Papers | |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition | |
| <input type="checkbox"/> Affidavits/declarations(s) | <input type="checkbox"/> Petition to Convert to a Provisional Application | |
| <input checked="" type="checkbox"/> Extension of Time Request (4 month) | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Terminal Disclaimer | |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Request for Refund | |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> CD, Number of CD(s) _____ | |
| <input type="checkbox"/> Response to Missing Parts- Incomplete Application | Remarks | |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | |
|--|---|
| Firm or Individual name | Jeffrey L. Costellia Nixon Peabody LLP 8180 Greensboro Drive Suite 800 McLean, VA 22012 |
| Signature | |
| Date | April 13, 2001 |

| CERTIFICATE OF MAILING | |
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| | |
| Pamela L. Patrick | |

**FEE TRANSMITTAL
FOR FY 2001**

Patent fees are subject to annual revision

**Complete if Known**

Application Number 08 926,592
 Filing Date September 9, 1997
 First Named Inventor Shunpei YAMAZAKI
 Examiner Name M. Whipple
 Group Art Unit 2813
 Attorney Docket No 740756-1717

TOTAL AMOUNT OF PAYMENT**METHOD OF PAYMENT**

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number 19-2380

Deposit Account Name Nixon Peabody LLP

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

- ☐ Applicant claims small entity status See 37 CFR 1.27

2. ☐ **Payment Enclosed:**

☐ Check ☐ Credit Card ☐ Money Order ☐ Other

FEE CALCULATION**1. BASIC FILING FEE**

| Large Entity Fee Code | Large Entity Fee (\$) | Small Entity Fee Code | Small Entity Fee (\$) | Fee Description | Fee Paid |
|-----------------------|-----------------------|-----------------------|-----------------------|------------------------|----------|
| 101 | 710 | 201 | 355 | Utility filing fee | |
| 106 | 320 | 206 | 160 | Design filing fee | |
| 107 | 490 | 207 | 245 | Plant filing fee | |
| 108 | 710 | 208 | 355 | Reissue filing fee | |
| 114 | 150 | 214 | 75 | Provisional filing fee | |

SUBTOTAL (1) (\$)**2. EXTRA CLAIM FEES**

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| 20** | X | | |
| Independent Claims | 3** | X | |
| Multiple Dependent | | | |

| Large Entity Fee Code | Large Entity Fee (\$) | Small Entity Fee Code | Small Entity Fee (\$) | Fee Description | Fee Paid |
|-----------------------|-----------------------|-----------------------|-----------------------|--|----------|
| 103 | 18 | 203 | 9 | Claims in excess of 20 | |
| 102 | 80 | 202 | 40 | Independent claims in excess of 3 | |
| 104 | 270 | 204 | 135 | Multiple dependent claim, if not paid | |
| 109 | 80 | 209 | 40 | ** Reissue independent claims over original patent | |
| 110 | 18 | 210 | 9 | ** Reissue claims in excess of 20 and | |

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

| Large Entity Fee Code | Large Entity Fee (\$) | Small Entity Fee Code | Small Entity Fee (\$) | Fee Description | Fee Paid |
|-----------------------|-----------------------|-----------------------|-----------------------|--|----------|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 139 | 130 | 139 | 130 | Non-English transaction | |
| 147 | 2,520 | 147 | 2,520 | For filing a request for <i>ex parte</i> reexamination | |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | |
| 115 | 110 | 215 | 55 | Extension for reply within first month | |
| 116 | 390 | 216 | 195 | Extension for reply within second month | |
| 117 | 890 | 217 | 445 | Extension for reply within third month | |
| 118 | 1,390 | 218 | 695 | Extension for reply within fourth month | 1,390 |
| 128 | 1,890 | 228 | 945 | Extension for reply within fifth month | |
| 119 | 310 | 219 | 155 | Notice of Appeal | |
| 120 | 310 | 220 | 155 | Filing a brief in support of an appeal | |
| 121 | 270 | 221 | 135 | Request for oral hearing | |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable | |
| 141 | 1,240 | 241 | 620 | Petition to revive - unintentional | |
| 142 | 1,240 | 242 | 620 | Utility issue fee (or reissue) | |
| 143 | 440 | 243 | 220 | Design issue fee | |
| 144 | 600 | 244 | 300 | Plant issue fee | |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | |
| 123 | 50 | 123 | 50 | Petitions related to provisional applications | |
| 126 | 180 | 126 | 180 | Submission of Information Disclosure Stmt | |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) | |
| 146 | 710 | 246 | 355 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 149 | 710 | 249 | 355 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 179 | 710 | 249 | 355 | Request for Continued Examination (RCE) | |
| 160 | 900 | 160 | 900 | For each additional examination of a design application | |

Other fee (specify)

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* Reduced by \$11,390.00

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Name Jeffrey E. Costellina

Signature

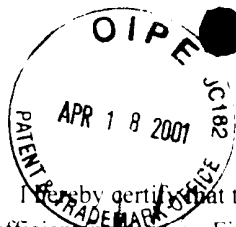
Amount \$35,483

Date

Amount \$11,390.00

Date April 13, 2001

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Pamela L. Patrick
Pamela L. Patrick

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-----------------------------|---|----------------------|
| In re Patent Application of |) | |
| Shunpei YAMAZAKI |) | |
| Serial No. 08/926,592 |) | Art Unit: 2813 |
| Filed: September 9, 1997 |) | Examiner: M. Whipple |
| For: LAYER MEMBER FORMING |) | |
| METHOD |) | Date: April 13, 2001 |

RESPONSE TO ELECTION OF SPECIES

Honorable Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

In response to the request for election of species in the Office Action of November 15, 200, Applicant hereby elects with traverse species IV (claim 26).

The Office Action provides that claim 13 is generic to Species I, II, III and VI. Applicant contends that claim 13 is generic to species IV since claim 13 recites the vapor deposit of two layers wherein the material of the two layers is not specified.

Applicant also contends that the instant election of species is improper since it is brought after two actions on the merits. Although M.P.E.P. 811 provides that an election requirement can be made any time prior to a final rejection, the Examiner is instructed to make such a requirement as early as possible, in the first action if possible, otherwise, as soon as the need for a proper requirement arises. Further, the Examiner is instructed to consider whether there will be a serious burden if restriction is not required when made

Applicant's response resulting in the withdrawal of the pending claims and the addition of new claims. Moreover, this amendment was filed in response to the first action on the merits.

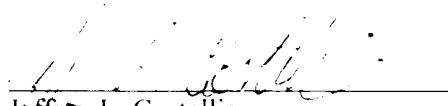
not the second. Further, although the amendments to the claims were broadening in nature, they did not result in a fundamental change from the invention originally claimed. As a result, the designation of 10 different species at this stage in the prosecution is highly burdensome to Applicant since time and investment have already been made by Applicant in this case on two different occasions to obtain allowance of the pending claims.

This type of species election is also inconsistent with standard claiming practice wherein an application may contain a number of claims of varying scope that may be patentably distinct from one another, but also properly considered in the same application. Just because many of the claims falling within the designated species are independent claims does not give rise to a proper species election requirement. Otherwise, the same reasoning would have to be applied to ever increasingly narrow dependent claims included in the same application, since dependent claims are treated as stand alone claims for examination and infringement purposes. If the species election of the instant Office Action were proper, applications could basically only include two claims, namely, one generic claim and one more specific claim. This is particularly true with respect to the dependent claims grouped separately by the Examiner in this case as separate species.

It should be noted that these arguments do not assert and should not be construed to assert that the embodiments provided in each of the designated species are not patentably distinct from one another.

Filed Concurrently herewith is a Request for a Four Month Extension of Time which extends the shortened statutory period of response to April 15, 2001. Accordingly, applicant respectfully submits that this response is being timely filed.

Respectfully submitted,



Jeffrey L. Costellia
Registration No. 35,483

NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800